

Amendment

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Remarks/Arguments

In the specification, the brief description of the drawings and the description of the preferred embodiments have been amended to describe Fig. 3 which illustrates an embodiment of the invention wherein the polishing layer comprises multiple layers. In newly added Fig. 3, the multiple layer polishing layer embodiment is shown.

Claims 7, 9, 11, 13, 14 and 16-26 remain in this application. Claim 7 has been amended and new claim 27 has been added. As amended, claim 7 is no longer limited to porous foam resins. Applicants have determined that the invention should not be limited to porous foam resins but have maintained this aspect of the invention in new claim 27.

In the Office action dated October 29, 2003, the drawings were objected to under 37 C.F.R. §1.83(a) for failing to show every feature of the invention specified in the claims. Therefore, applicants have added Fig. 3 which illustrates the embodiment wherein multiple layers make up the polishing layer. Applicants submit that no new matter has been added with the inclusion of Fig. 3 which is described at page 5, lines 16-25 of the application. Although applicants have submitted new Fig. 3 in response to the objection, applicants respectfully submit that the invention is adequately shown in the drawings as originally submitted. Drawings are not typically required for claims directed to a coated article or product or for laminated articles or products. *See* MPEP 608.02.

Claims 7, 9, 11, 13, 14 and 16-26 stand rejected as being unpatentable over Nokubi et al. in view of Kitajima et al. and Kimura et al. This rejection is respectfully traversed for the following reasons.

The Office action acknowledges that Nokubi fails to disclose or suggest a polishing layer comprising a flexible layer formed on the surface of the core. It relies on the other two references for disclosure of this missing element. Applicants respectfully submit that a *prima facie* case of obviousness has not been established with respect to the pending application

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because the cited references fail to provide the requisite motivation to combine and modify the references to arrive at the present invention.

A determination of obviousness based on a combination of elements disclosed in the prior art must include some reference to a motivation, suggestion or teaching to combine the references. See, e.g., *In re Dance*, 160 F.3d 1339, 1343, 48 U.S.P.Q. 2d (BNA) 1635, 1637 (Fed. Cir. 1998). The motivation, suggestion or teaching may come from the prior art, the knowledge of one skilled in the art or from the nature of the problem to be solved. *In re Dembiczak*, 175 F.3d 994,999, 50 U.S.P.Q. 2d (BNA) 1614, 1617 (Fed. Cir. 1999). A finding of obviousness without particular findings as to the motivation or suggestion in the prior art for combining the references is an impermissible use of hindsight based on the Applicants' application. *In re Paulsen*, 31 U.S.P.Q. 2d 1671, 1676 (Fed. Cir. 1994) ("Multiple cited prior art references must suggest the desirability of being combined, and the references must be viewed without the benefit of hindsight afforded by the disclosure.").

The Office action indicates that it would have been obvious to modify the abrasive material of Nokubi with a polishing layer comprising a flexible layer formed on the surface of the core and the abrasive in view of Kitajima et al. and Kimura et al. The Office action indicated that the motivation for combining the references was to retain the abrasive particles on the core during the polishing process. The applicants respectfully submit that the necessary motivation for combining these references is not present. The motivation to combine must be "clear and particular" and in the present case the purported motivation is neither.

Specifically, one of ordinary skill in the art would not have been motivated to combine either of these references with Nokubi because they relate to entirely different types of abrasive materials. For example, Kitajima discloses a segmented grinding wheel for use in a grinding machine and Kimura discloses a polishing material for polishing a silicon wafer. By contrast, the abrasive material of the present invention is for use in a surface finishing process and the abrasive material is sprayed to the surface of the work to provide the necessary finishing. One of skill in the art reading the Nokubi reference would not be motivated to look to either of the cited

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references because they are simply not pertinent to any problems associated with the surface finishing process described in the present application and in Nokubi.

To establish a *prima facie* case of obviousness there must be some motivation or suggestion in the references that would lead one of ordinary skill in the art to combine the various components, without knowledge of the claimed invention, to obtain the present invention. *In re Kotzab*, 217 F. 3d 1365, 1371, 55 U.S.P. Q. 2d (BNA) 1313, 137 (Fed. Cir. 2000) (“particular findings must be made as to the reason the skilled artisan, with knowledge of the claimed invention, would have selected these components for combination in the manner claimed”). The mere identification of the various components in the prior art references is insufficient to render the present invention obvious. The motivation or suggestion “must be considered in the context of the teaching of the entire reference.” *Id.* One of skill in the art reading the Nokubi et al. reference would not be motivated to turn to art relating to grinding wheels or polishing sheets for providing abrasive materials with a flexible layer for use in spray applications. The references are devoid of any suggestion of picking and choosing various features of each reference to arrive at the present invention. One of skill in the art could never arrive at the present invention based on any motivation or suggestion in the references without the benefit of the applicants’ disclosure. Accordingly, applicants submit that the claims of the present application are not obvious over the cited references.


In light of the foregoing response, it is respectfully submitted that the claims now pending are patentably distinct from the references cited and are in condition for allowance. Reconsideration and withdrawal of the rejections of record is respectfully requested. If the examiner wishes to discuss any aspect of this response, please contact the undersigned at the telephone number indicated below.

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Respectfully submitted,



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